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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Charles O. Townley
Serial No. 10/758,455
Filing Date 01/15/2004
Docket No. THUMB-604DIV
MODULAR BASAL THUMB JOINT IMPLANT

Attn: Group Art Unit 3738
Primary Examiner
Brian E. Pellegrino
Amendment

Commissioner for Patents, Alexandria, VA 22313-1450:

I certify that this correspondence is facsimile-transmitted to the Patent and Trademark Office (571 273 8300) on 17 APR 2007:

Christopher John Rudy: Christopher John Rudy 4/17/2007.

Thank you for the 01/17/2007 Office action for the present application. In reply to that action, please reconsider and further examine the application, and in light of the present correspondence withdraw the standing rejections.

CLAIMS AMENDMENTS are attached hereto.

This amendment more particularly points out and distinctly claims the invention, and is fully supported by the original and underlying specifications, including drawings. No new matter is added hereby. Claims 21-42 remain present. No extra fee is due.

Insofar species A is cited as a one-piece basal thumb joint implant, the traverse of the 35 USC 121 restriction of species is withdrawn. All present claims, which require modularity, read on the thus elected and examined species, B, C and D.

As may apply to the present claims, each of the rejections set forth in the outstanding action is respectfully traversed.

Regarding the rejection of claims 21-24, 26, 40 and 41 under 35 USC 102(b) over Townley, US 2934065, each of claims 21 and 41 requires a head of a size for mounting in and articulating with a correspondingly concavely prepared surface of trapezium bone stock, and its stem of a size for intramedullary insertion in metacarpal bone stock. Such size limitations are material claim elements and must be taken into account. See, In re Marshall, 578 F.2d 301 [198 USPQ 344, 346] (CCPA 1978). Townley '065 does not describe either of these size limitations. In fact, the device of Townley '065 is a hip implant, which is well known to be much larger than a basal thumb joint implant. Moreover, modularity to the hip implant of Townley '065 is not described, and unlike that found in some present claims, no general angle of projection in Townley '065 is acute; it is perpendicular. Thus, claims 21, 22, 40 and 41 distinguish over Townley, and, by virtue of their dependence, claims 23, 24 and 26 distinguish as well.

FURTHER REMARKS conclude the present paper (pages 7-11).

Submitted herewith is a Declaration with Exhibits.